Remarks

The response is timely because it is filed within the three month shortened statutory period of the mailing date of the Office action, i.e., August 11, 2006.

Final Action or Not?

The Office Action of August 11 is the first Office action following the filing of a Request for Continued Examination (RCE); amended claims were filed with the RCE. The Summary of the Office action has both boxes 2a (FINAL) and 2b (NON-FINAL) checked, and the heading on PAIR indicates that the action was final, but there is no other indication in the paper that it is a final Office action. The applicant respectfully submits that the action should not be final. The Examiner is respectfully requested to confirm that the Office action of August 11, 2006, is not a final action. If the action is intended to be final, the applicant respectfully requests that the finality of the Office action be removed.

35 U.S.C. § 103(a) (Obviousness)

Claims 1-2 and 5-64 are pending in the present application. The Office action rejects claims 1-2, 5-8, 11-32, 35-46, and 49-64 under 35 U.S.C. § 103(a) as being unpatentable over the Segal et al. reference (US 2001/0041991), in view of the Joao reference (US 6,283,761). The applicant notes with appreciation that the previous rejections under 35 U.S.C. § 102 have been withdrawn.

Claims 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of the Judson et al. reference (US 2005/0026117). Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of the Mok et al. reference (2003/0140044). The applicant respectfully traverses these rejections and submits that all pending claims are patentable over the prior art and Official Notice of record.

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In order for a 35 U.S.C. §103 rejection to be proper, a *prima facie* case of obviousness must be established. The *MPEP* states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP, § 2142 (emphases added). If any of the three criteria is not met, the 35 U.S.C. §103 rejection must be withdrawn.

The Office action indicates that the Segal reference fails to disclose (underlines original):

> A method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provide to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:
>
>   (4)   storing said medical record without data processing said medical record;
>
>   (5)   obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and
>
>   (6).   transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.

At least some of the missing features of the Segal reference, however, are not found in the applied prior art.

The Joao reference does not disclose a method allowing a service provider, who is not the patient or a covered entity, to quickly disclose the medical record of a patient to a

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third party without restriction by the Health Insurance Portability and Accountability Act of 1996 (HIPAA).

All the claims of the present application require that the service provider is <u>not the patient or a covered entity</u> under HIPAA and does not engage in data processing of the patient's medical record. The applicant has shown to the Examiner in the response to the last Office action, and the Examiner has agreed in this Office action, that the Segal reference does not teach or suggest a service provider who is not a covered entity under HIPAA inducing the patient to do the steps recited in the present claims, because the Segal reference necessarily describes the service provider engaging in data processing, thus becoming a health care clearinghouse and itself a "covered entity." The Joao reference or the Official Notice of record cannot overcome this deficiency.

More specifically, the Office action finds that the Joao reference teaches a method wherein the service provider stores the medical record <u>without data processing</u> the medical record. However, this claim limitation is not taught or suggested by the Joao reference. To the contrary, the Joao reference, as cited at Col. 3, lines 25-45 in the Office action, states:

> <u>The apparatus also includes an intermediary communication device or computer which is associated with an intermediary</u>, a broker, an agent, and/or any other individual and/or entity, that can utilize the present invention in order to act for and/or on behalf of any other individual, party, or entity, described herein. <u>The intermediary computer(s) can</u> communicate with, and <u>operate in conjunction with, central processing computer</u> and any of the other computers and/or computer systems described herein.

> Each of the central processing computer(s), the provider computer(s), the payer computer(s), the patient computer(s), and/or the intermediary computer(s), can transmit information to, as well as receive information from, any of the computers described herein. In this regard, <u>each of the computers can</u> communicate with, <u>process information from</u>, and/or share data and/or information with, <u>each other and/or any other computer or computers described herein and/or utilized in conjunction with the present invention</u>. In this manner, data and/or information transfer between any of the computers can take place in a bi-directional manner.

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(Underlining added.) This passage necessarily describes the service provider engaging in data processing and, at least in some embodiments, diagnosing. Therefore, the service provider of the Joao reference is inevitably a "covered entity" (or a "business associate" of a "covered entity") under HIPAA as, for example, a "health care clearinghouse" or a "health care provider who transmits any health information in electronic form in connection with a transaction." *See* 45 C.F.R. § 160.103; see 42 U.S.C. § 1320d-1(a).

Paragraph [0034] of the present specification provides the HIPAA definitions of a "health care clearinghouse" and a "health care provider":

> A health care clearinghouse ("HCC") is a "public or private entity" that either "[p]rocesses or facilitates the processing of health information received from another entity in a nonstandard format or containing nonstandard data content into standard data elements or a standard transaction" or "[r]eceives a standard transaction from another entity and processes or facilitates the processing of health information into nonstandard format or nonstandard data content for the receiving entity." 45 C.F.R. § 160.103; see also 42 U.S.C. § 1320d(2) (defining "health care clearinghouse"). A health care provider is a "provider of medical or health services," including any "person or organization [that] furnishes, bills or is paid for health care in the normal course of business." 45 C.F.R. § 160.103; see also 42 U.S.C. § 1320d(3) (defining "health care provider"). To be a business associate, the person performing the function or activity must be either doing so "on behalf of" a covered entity or providing a service "for" the covered entity that has provided the person with protected information. 45 C.F.R. § 160.103; see Standards, 65 Fed. Reg. at 82476

Therefore, processing health information from one format to another, under this definition, is data processing, and any provider of medical or health service is a health care provider.

The Joao reference clearly provides that the apparatus and method of its invention are "for providing a comprehensive processing system which incorporates data and/or information from any combination and/or all of the participants in the healthcare field, including patients, providers, payers or insurance companies, and/or brokers, agents and/or other intermediaries who act on behalf of any of the above-identified persons or

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entities." Col. 2, lines 55-62 (emphasis added). The Joao reference further teaches, for example,

> In any and/or all of the embodiments described herein, <u>any of the data</u> and/or information which is or which may be stored in the database 10H, and/or any of the other databases described herein, <u>can be utilized and/or can appear in any of the reports,</u> diagnostic reports, treatment reports, evaluation reports, provider reports, payer reports, patient reports, training reports, and/or any other reports, described herein.

Col. 20, lines 20-27. In order to perform these functions, the method and apparatus of the Joao reference necessarily process medical data provided by a patient. There is no teaching in the Joao reference, either in the isolated passages relied on by the Examiner or anywhere else, for storing a medical record without data processing the medical record so as to avoid the service provider from becoming a "covered entity" of HIPAA.

To the contrary, the Joao reference explicitly teaches the service provider of its invention to be a covered entity. For example, it teaches that its invention can be utilized as a health care "clearinghouse." Col. 24, lines 44-48. For another example, it teaches that its invention can "perform a comprehensive diagnostic evaluation of the patient's symptoms," which will make the service provider of its invention a health care provider and thus a covered entity of HIPAA.

Therefore, the Joao reference does not teach a service provider who is not a covered entity of HIPAA and who does not process data, but only stores and transmits data as presented by the patient. The Mok and Judson references, which are applied to reject claims 9-10 or 33-34 in combination with the Segal and Joao references and Official Notice, also do not teach a method in which the service provider stores medical record without data processing the medical record.

The Office action, page 5, item 6, employs Official Notice (see Section 2144.03 MPEP), to support the position that it is generally known to "transmit[ ] said medical record to a third party when the defined conditions occur, <u>without data processing</u> said medical record (Official Notice: See step (5) above.)." This position is respectfully traversed

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because it contradicts the Joao reference, and thus cannot be understood to be common knowledge or well known in the art. As explained above, Joao specifically contemplates data processing in connection with communicating data. See Section 2144.03 MPEP, 8th Ed., Rev. 5 ("It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.").

Therefore, the prior art references of record, either alone or in combination, do not teach or suggest all the claim limitations of the independent claims 1, 19, and 30 of the present application. For this reason alone, no obviousness can be established, and the rejection must be withdrawn. *See MPEP*, § 2142.

Claims 2, 5-18, 20-29, and 31-64 all depend from claim 1, 19, or 30, and therefore, they are patentable at least for the same reasons as for claims 1, 19, and 30.
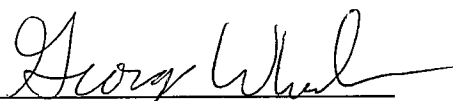
Conclusion

In view of the above remarks, the applicant respectfully requests reconsideration and allowance of all the pending claims (1-2 and 5-64).

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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By:_____

George Wheeler
Reg. No. 28,766
Attorney for Applicant(s)

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
Chicago, IL 60661
Telephone: (312) 775-8000
FAX: (312) 775-8100

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